UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,907	10/09/2003	Wayne H. Rothschild	47079-0200P1	7700

70243 7590 06/15/2007

NIXON PEABODY LLP
161 N CLARK ST.
48TH FLOOR
CHICAGO, IL 60601-3213

EXAMINER	
HSU, RYAN	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
06/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/681,907	ROTHSCHILD ET AL.	
	Examiner	Art Unit	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/11/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-4 and 12-15, and 23 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 and 11-14 and 21 of copending Application No. 10/457,629. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The claims of the two co-pending applications are identical in language and scope and are duplicates of one another.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-31 of copending Application No. 10/457629. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: both sets of claims are directed towards "a gaming machine for conducting a wagering game, comprising: a game display for displaying the wagering game; and an alterable signange display including a mechanical display member movable between a first position and a second position, the display member display first and second signage information to a player when in the respective first and second positions, the signange information being free of random events and outcomes associated with the wagering game". The two sets of claims have identical limitations except the instant application incorporates the signange using a video display as opposed to a mechanical display. However these two types of displays are well known in the art to be interchangeable therefore is an obvious type variation of the previously presented scope in copending application '629.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Information Disclosure Statement

The information disclosure statement filed 10/09/03 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement notification has been placed in the application file, but the information referred to therein has not been considered as no copy of the IDS was provided in the notification.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The current claims attempts to claim a wagering game machine that contains a display for displaying the wagering game. Additionally, the claims are directed towards an alterable signage display that includes a mechanical display member movable between positions but is not associated with the wagering game. The current claims is drafted to embrace or overlap two different statutory classes of invention and is precluded by the expressed language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. In this instance, the claim is intended to embrace two distinct products or machines and is precluded by the language of 35 U.S.C. 101 for claiming two displays that in the language of the claims are not interactive or relating to one another other than co-existing in the same claim (*see 'Hybrid' claim of MPEP 2173).*

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The current claims attempts to claim a wagering game machine that contains a display for displaying the wagering game. Additionally, the claims are directed towards an alterable signage display that includes a mechanical display member movable between positions but is not associated with the wagering game. The claims which purports to be dual displays of a wagering game wherein the second display in not associated with the wagering game precludes itself from being an integral part of the actual invention. Therefore the two distinct inventions

that exist in the claim are ambiguous and therefore does not particularly point out and distinctly claim subject matter of the invention. The current claim is which appears to be a "hybrid" and is permitted in U.S. patent practice but only in special circumstances. One in particular is a product-by-process claim, which does not violate the rules because a process limitation is used to define a product and therefore these type of claims are considered to be directed toward one product only. However, the claims of the current application are directed towards more than one single inventive device within a single claim (*see MPEP 2173*).

Furthermore, claims 5-8, 16-19, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As the subject matter of the claims is directed towards a gaming machine for conducting a wagering game with a game display for displaying the wagering game and an "alterable signage display portraying a mechanical display member moveable between a first and second position". However, claims 5-8, 16-19 and 24 are directed towards a signange display as a "video" display. It is unclear how a signange display can be a mechanical display apparatus and also manifest itself as a mechanical display apparatus. Unless the applicant feels that a video display is a mechanical apparatus and therefore a mechanical display and video display are equivalent devices. It is unclear what is meant by an alterable signage display portraying a mechanical display member that is a signanage display device that is a video display. Due to the indefiniteness of the claims the examiner has interpreted the claims concerning the alternable display as a video display and mechanical display being interchangeable equivalents.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9, 11-14, 19, 21-22, 25-27, and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Seelig et al. (WO 98/14251).

Regarding claims 1 and 12, Seelig et al. discloses a gaming machine for conducting a wagering game, comprising: a game display for displaying the wagering game (*see display [22] of Fig. 1 and the related description thereof*); and an alterable signage display including a mechanical display member movable between a first position and a second position, the display member displaying first and second signage information to a player when in the respective first and second positions, the signage information being free of random events and outcomes associated with the wagering game (*see animated robot [14] of Fig. 1 and the related description thereof*).

Regarding claim 23, Seelig et al. discloses a gaming machine for conducting a wagering game comprising: a game display for displaying the wagering game (*see display [22] of Fig. 1 and the related description thereof*); and a signage display including a flexible display member scrollable between a first and second signage information to a player when in the respective first and second positions, the signage information being free of random events and outcomes associated with the wagering game.

Regarding claims 2 and 12, Seelig et al. discloses a game machine wherein the signage information is selected from a group consisting of billboard information, advertisement

information, player attraction material (*see Fig. 1 and the related description thereof*), pay table information, bonusing information, game help information, game play instructions, and thematic artwork.

Regarding claims 3 and 13, Seelig et al. a game machine wherein the wagering game is selected from a group consisting of reels slots, poker, keno, bingo, blackjack, and roulette (*see pg. 4, Fig. 1 and the related description thereof*).

Regarding claims 4 and 14, Seelig et al. executing the wagering game and operating, at least indirectly, the signage display (*see abstract, Fig. 1 and the related description thereof*).

Regarding claims 9 and 20, Seelig et al. a game machine wherein the game display is selected from a group consisting of mechanical reel spinning display and a video display (*see reels [22] and robot [14] of Fig. 1 and the related description thereof*).

Regarding claims 10 and 21, Seelig et al. discloses a gaming machine including a cabinet and a top box mounted on top of the cabinet, the game display being mounted within the cabinet, the signage display being mounted within the top box (*see Fig. 1 and the related description thereof*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 12, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crouch (GB 2,171,235 A).

Regarding claims 1 and 12, Crouch teaches a gaming machine for conducting a wagering game, comprising: a game display for displaying the wagering game (*see Fig. 1 and the related description thereof*); and an alterable signage display including a mechanical display member movable between a first position and a second position, the display member displaying first and second signage information to a player when in the respective first and second positions, the signage information being free of random events and outcomes associated with the wagering game (*see Fig. 1 and the related description thereof*).

Regarding claim 23, Crouch teaches a gaming machine for conducting a wagering game comprising: a game display for displaying the wagering game (*see Fig. 1 and the related description thereof*); and a signage display including a flexible display member scrollable between a first and second signage information to a player when in the respective first and second positions, the signage information being free of random events and outcomes associated with the wagering game (*see pg. 1: ln 5-75, pg. 1: ln 126-pg. 2: ln 3*).

Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig et al. (WO 98/14251) as applied to claims above, and further in view of Seelig et al. (US 6,338,678 B1).

Regarding claims 10 and 22, Seelig et al. teaches a gaming machine wherein the wagering game with a form of a displaying signage information related to the game machine. However it is silent with regard to a basic game and bonus game event. Seelig et al. in an analogous gaming patent includes a basic game and a bonus event being triggered by a start-

bonus outcome in the basic game (*see slot machine [22-24] and bingo bonus event [16,18] of Fig. 1(a-b) and the related description thereof*), wherein the display member displays the first signage information during the basic game and the second signage information during the bonus game (*see Fig. 1b and the related description thereof*).

Seelig et al. ('678) teaches a gaming machine that is operable to conduct a plurality of different wagering games, wherein the display mechanism displays one of the first and second sides during a first of the wagering games and the other on the first and second sides during a second of the wagering games (*see Fig. 1b and the related description thereof*).

The introduction of Seelig '678 has been used to teach a basic game and bonus game that uses a signage display to attract players towards the game machine. It is old and well known that bonus games have been incorporated into slot machines and therefore would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the signage robot of Seelig '251 with Seelig '678 in order to have a common game machine with a bonus game that would attract players through a large signage display.

Claims 6-9 and 17-19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seelig et al. (WO 98/14251) and Bennett et al. (WO 00/32286) and in further view of Crouch (GB 2,171,235 A).

Regarding, Seelig et al. discloses a gaming machine for conducting a wagering game, comprising: a game display for displaying the wagering game (*see display [22] of Fig. 1 and the related description thereof*); and an alterable signage display including a mechanical display member movable between a first position and a second position, the display member displaying first and second signage information to a player when in the respective first and second positions,

the signage information being free of random events and outcomes associated with the wagering game (*see animated robot [14] of Fig. 1 and the related description thereof*). However, Seelig is silent with respect to a signage display being a video display.

In a related gaming patent, Bennett teaches a player information delivery system that incorporates a video display in order to attract customers in the form of a signage display (*see Fig. 19(a-b) and the related description thereof*). One would be motivated to incorporate the features of Bennett into that of Seelig to show that video and mechanical displays are interchangeable used as signage devices. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bennett into that of Seelig at the time the invention was made. However, Seelig and Bennett are still silent with respect to certain features of the mechanical display member.

In an analogous gaming patent, Crouch teaches of a mechanical display member that is incorporated with a game. Crouch teaches the following features:

Regarding claims 7 and 17, Crouch teaches a mechanical display member that includes scrolling media movable by one or more rollers between the first and second positions (*see Fig. 1 and the related description thereof*).

Regarding claims 8-9 and 18-19, Crouch teaches a mechanical display member that includes a plurality of panels rotatable about respective axes between the first and second positions (*see Fig. 1 and the related description thereof*), each of the panels displaying first and second sides to the player when in the respective first and second positions, each of the panels display first and second sides to the player when in the respective first and second positions, the

first and second signage information being displayed on the respective first and second sides of the panels (*see Figs. 1-2 and the related description thereof*).

One would be motivated to incorporate the teachings of Crouch with that of Seelig and Bennett to show different features that may be implemented in a mechanical display device. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made modify the mechanical display device of Seelig with that of Crouch to provide various types of movement that can be implemented into a mechanical display device.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E Pezzuto can be reached at (571)-272-6996.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH

May 24, 2007

/Scott Jones/
Primary Examiner, Art Unit 3714